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		2661		

DATE MAILED: 03/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/751,037	SALLAWAY ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Ian N Moore	2661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 8-23-2004.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-51 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) 39-51 is/are allowed.  
 6) Claim(s) 1-38 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 09 April 2001 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Claims 1-38 are rejected by the same ground of rejections.

### ***Specification***

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

Abstract lines 7-8 contain the legal phraseology “**comprises**”.

The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-7,9-16,18-24, and 26-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Herve (U.S. 5,740,163).

**Regarding Claim 18**, Herve'163 discloses a network transceiver that is couplable to a computer system (see FIG. 1, Dual-mode ISDN/STN transmitter/receiver which couples to the terminal):

an encoder (see FIG. 1, the combined system of Audio/Video encoder CODEC 13/14/6/25) that encodes data to be transmitted by said network transceiver (see col. 1, lines

29-35; see col. 2, lines 39-44, 56-66; note that each encoder encodes the transmit data by the terminal);

a decoder (see FIG. 1, the combined system of Audio/Video decoder CODEC 13/14/6/25) that decodes data received by said network transceiver (see col. 1, lines 29-35; see col. 2, lines 39-44, 56-66; note that each decoder decodes the received data by the terminal); and

a controller (see FIG. 1, Management System 18), associated with said decoder and said encoder (see FIG. 1, note that Management System associates/relates to the encoder and decoder by way of Mux/Demux 14 and a switch 28), that controls operating modes of said network transceiver (see col. 3, lines 19-40; Management System 18 manages/controls the operation modes of the terminal), comprising:

an encoder portion operable to direct said encoder to encode data (see FIG. 1, CODEC 13 and 6 are directed to perform/encode in RNIS, and/or CODEC 24 and 25 are directed to perform/encode in RTC) in one of an industry-compliant mode (see FIG. 1, ISDN mode when the switch 28 is at RNIS) and a custom mode (see FIG. 1, STM mode when the switch 28 is at RTC; see col. 3, lines 40-65); and

a decoder portion operable (see FIG. 1, CODEC 13 and 6 are directed to perform/decode in RNIS, and/or CODEC 24 and 25 are directed to perform/decode in RTC), in response to sensing data received in said custom mode at said decoder (see col. 3, lines 63 to col. 4, lines 5; note that the data is received at the decoder in STM mode), to direct:

said decoder to decode said received data in said custom mode (see FIG. 1, note that in STM mode switch 28 must be toggled to RTC; upon receiving the data in STM mode,

STM decoder RTC 34/38 must be directed/programmed/assigned to decode the data; also note that per FIG. 1 and 2, it is clear that each STM decoder part/portion must decode the data); and

said encoder portion to direct said encoder to encode data in said custom mode (see FIG. 1; during STM mode, STM encoder RTC 33/37 must be directed/programmed/assigned to encode the data; also note that per FIG. 1 and 2, it is clear that each STM encoder part/portion must encode the data); see col. 3, lines 40-65.

**Regarding Claim 1**, the system claim, which has substantially disclosed all the limitations of the respective claim 18. Therefore, it is subjected to the same rejection.

**Regarding Claim 2**, Herve'163 discloses a state machine (see FIG. 1, the combined system of management terminal, HDLC controller 21, and switch 28) that includes at least two alternate states indicating whether said custom mode is enabled (see col. 3, lines 19-40,62-67 to col. 4, lines 2; note that the combined management system controls both STM and ISDN modes, and controller indicates the STM mode by enabling the switch to RTC).

**Regarding Claim 3**, Herve'163 discloses wherein at least said decoder portion is embodied in a peripheral card that is couplable to a computer system (see FIG. 1, the combined system of Audio/Video decoder CODEC 13/14/6/25 portion/chip/ASIC must be attached/embedded in a peripheral card/unit which is coupled to the terminal/system which has a capability to compute/determine which mode to use) to allow said computer system to process said decoded data (see FIG. 1, the computing/determining terminal/system process decoded data); see col. 1, lines 29-35; see col. 2, lines 39-44, 56-66.

**Regarding Claim 4,** Herve'163 discloses a reset portion (see FIG. 1, a switch 28) that is operable to direct said controller to reset said operating mode of the network transceiver to said industry-compliant mode (see FIG. 1, note that switch 28 is controlled by the combined management system to reset/switch from STM mode (RTC) to ISDN mode (RNIS); see col. 3, lines 60-65.)

**Regarding Claim 5,** Herve'163 discloses wherein said reset portion is associated with said decoder portion and operates to direct said decoder portion (see FIG. 1, CODEC 13 and 6 RNIS are associated/related to switch 28 RNIS mode, they operate/perform/direct the decoding in RNIS) to direct:

    said decoder to decode said received data in said industry-compliant mode (see FIG. 1, note that in ISDN mode switch 28 must be toggled to RNIS; upon receiving the data in RNIS mode, ISDN decoder RNIS 32/36 must be directed/programmed/assigned to decode the data; also note that per FIG. 1 and 2, it is clear that each ISDN decoder must decode the data); and

    said encoder portion to direct said encoder to encode data in said industry-compliant (see FIG. 1; during ISDN mode, ISDN encoder RNIS 31/35 must be directed/programmed/assigned to encode the data; also note that per FIG. 1 and 2, it is clear that each ISDN encoder part/portion must encode the data); see col. 3, lines 40-65.

**Regarding Claim 6,** Herve'163 discloses wherein said decoder portion is further operable, in response to sensing data received in said industry-compliant mode at said decoder (see col. 3, lines 63 to col. 4, lines 5; note that the data is received at the decoder in ISDN mode), to direct said decoder to decode said received data from said industry-

compliant mode (see FIG. 1, upon receiving the data in RNIS mode, ISDN decoder RNIS 32/36 must be directed/programmed/assigned to decode the data; also note that per FIG. 1 and 2, it is clear that each ISDN decoder part/portion must decode the data); see col. 3, lines 40-65.

**Regarding Claim 7,** Herve'163 discloses wherein said decoder portion is further operable to direct said encoder portion to control data transmission from said encoder in said industry-compliant mode (see FIG. 1; note that in ISDN mode switch 28 must be toggled to RNIS, and both encoder and decoder must perform in ISDN mode, respectively. Then, ISDN encoder RNIS 31/35 must be directed/programmed/assigned to encode the data; also note that per FIG. 1 and 2, it is clear that each ISDN encoder part/portion must encode the data); see col. 3, lines 40-65.

**Regarding Claim 9,** the method claim, which has substantially disclosed all the limitations of the respective system claim 18. Therefore, it is subjected to the same rejection.

**Regarding Claim 10,** Herve discloses said decoder to decode said received data in said custom mode (see FIG. 1, note that in STM mode switch 28 must be toggled to RTC; upon receiving the data in STM mode, STM decoder RTC 34/38 must be directed/programmed/assigned to decode the data; also note that per FIG. 1 and 2, it is clear that each STM decoder part/portion must decode the data).

**Regarding Claim 11,** the claim, which has substantially disclosed all the limitations of the respective claim 2. Therefore, it is subjected to the same rejection.

**Regarding Claim 12,** the claim, which has substantially disclosed all the limitations of the respective claim 3. Therefore, it is subjected to the same rejection.

**Regarding Claim 13**, the claim, which has substantially disclosed all the limitations of the respective claim 4. Therefore, it is subjected to the same rejection.

**Regarding Claim 14**, the claim, which has substantially disclosed all the limitations of the respective claim 5. Therefore, it is subjected to the same rejection.

**Regarding Claim 15**, the claim, which has substantially disclosed all the limitations of the respective claim 6. Therefore, it is subjected to the same rejection.

**Regarding Claim 16**, the claim, which has substantially disclosed all the limitations of the respective claim 6. Therefore, it is subjected to the same rejection.

**Regarding Claim 19**, the claim, which has substantially disclosed all the limitations of the respective claim 2. Therefore, it is subjected to the same rejection.

**Regarding Claim 20**, the claim, which has substantially disclosed all the limitations of the respective claim 3. Therefore, it is subjected to the same rejection.

**Regarding Claim 21**, the claim, which has substantially disclosed all the limitations of the respective claim 4. Therefore, it is subjected to the same rejection.

**Regarding Claim 22**, the claim, which has substantially disclosed all the limitations of the respective claim 5. Therefore, it is subjected to the same rejection.

**Regarding Claim 23**, the claim, which has substantially disclosed all the limitations of the respective claim 6. Therefore, it is subjected to the same rejection.

**Regarding Claim 24**, the claim, which has substantially disclosed all the limitations of the respective claim 6. Therefore, it is subjected to the same rejection.

**Regarding Claim 26**, the method claim, which has substantially disclosed all the limitations of the respective system claim 18. Therefore, it is subjected to the same rejection.

**Regarding Claim 27,** the claim, which has substantially disclosed all the limitations of the respective claim 10. Therefore, it is subjected to the same rejection.

**Regarding Claim 28,** Herve'163 discloses encoding data in said industry-compliant mode (see FIG. 1, note that in ISDN mode, the switch 28 is toggled to RNIS; in RNIS mode, encoders RNIS 31/35 must encode the data); see col. 3, lines 40-6.

**Regarding Claim 29,** Herve'163 discloses decoding data in said industry-compliant mode (see FIG. 1, note that in ISDN mode, the switch 28 is toggled to RNIS; in RNIS mode, decoders RTC 32/36 must decode the data); see col. 3, lines 40-6.

**Regarding Claim 30,** Herve discloses a controller (see FIG. 1, Management System 18), associated with said decoder and said encoder (see FIG. 1, note that Management System associates/relates to the encoder and decoder by way of Mux/Demux 14 and a switch 28), that controls operating modes of said network transceiver (see col. 3, lines 19-40; Management System 18 manages/controls the operation modes of the terminal), comprising: an encoder portion operable to direct said encoder to encode data (see FIG. 1, CODEC 13 and 6 are directed to perform/encode in RNIS, and/or CODEC 24 and 25 are directed to perform/encode in RTC) in one of an industry-compliant mode (see FIG. 1, ISDN mode when the switch 28 is at RNIS) and a custom mode (see FIG. 1, STM mode when the switch 28 is at RTC; see col. 3, lines 40-65).

**Regarding Claim 31,** Herve discloses said decoder to decode said received data in said custom mode (see FIG. 1, note that in STM mode switch 28 must be toggled to RTC; upon receiving the data in STM mode, STM decoder RTC 34/38 must be

directed/programmed/assigned to decode the data; also note that per FIG. 1 and 2, it is clear that each STM decoder part/portion must decode the data).

**Regarding Claim 32,** the claim, which has substantially disclosed all the limitations of the respective claim 2. Therefore, it is subjected to the same rejection.

**Regarding Claim 33,** the claim, which has substantially disclosed all the limitations of the respective claim 3. Therefore, it is subjected to the same rejection.

**Regarding Claim 34,** the claim, which has substantially disclosed all the limitations of the respective claim 4. Therefore, it is subjected to the same rejection.

**Regarding Claim 35,** the claim, which has substantially disclosed all the limitations of the respective claim 5. Therefore, it is subjected to the same rejection.

**Regarding Claim 36,** the claim, which has substantially disclosed all the limitations of the respective claim 6. Therefore, it is subjected to the same rejection.

**Regarding Claim 37,** the claim, which has substantially disclosed all the limitations of the respective claim 6. Therefore, it is subjected to the same rejection.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 8,17,25 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herve'163 in view of Agazzi (U.S. 6,721,916).

**Regarding claim 8,** Herve'163 discloses wherein said industry-compliant mode as describe above in claims 1,9,18 and 26.

Herve'163 does not explicitly disclose IEEE 802.3ab.

However, the above-mentioned claimed limitations are taught by Agazzi'916. In particular, Agazzi'916 teaches wherein said industry-compliant mode is compliant with IEEE 802.3ab (**see FIG. 1, Transceiver block 102 which operates in conformance with IEEE 802.ab. standard; see col. 1, line 34-34, see col. 6, lines 11-20**).

In view of this, having the system of Herve'163 and then given the teaching of Agazzi'916, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Herve'163, by utilizing IEEE 802.ab. as industrial/standard mode, as taught by Agazzi'916. The motivation to combine is to obtain the advantages/benefits taught by Agazzi'916 since Agazzi'916 states at col. 1, line 46 to col. 2, lines 4 that such modification would provide a smooth and non-disruptive evolution from existing standard, and lower cost than other technologies of comparable speed.

**Regarding Claim 17,** the claim, which has substantially disclosed all the limitations of the respective claim 8. Therefore, it is subjected to the same rejection.

**Regarding Claim 25,** the claim, which has substantially disclosed all the limitations of the respective claim 8. Therefore, it is subjected to the same rejection.

**Regarding Claim 38,** the claim, which has substantially disclosed all the limitations of the respective claim 8. Therefore, it is subjected to the same rejection.

***Allowable Subject Matter***

7. Claims 39-51 are allowed.

***Response to Arguments***

8. Applicant's arguments filed 8-23-2004 have been fully considered but they are not persuasive.

**Regarding claims 1-7,9-16,18-24 and 26-37, the applicant argued that,** “...Herve lacks any mention of determining how to encode data using an encoder based on data received by a decoder...Herve fails to anticipate sensing the mode in which incoming information was encoded and then using this mode to both decode the incoming information and to encode outgoing information...” in page 19, paragraph 2, and “...Herve fails to anticipated “sensing data received at a decoder in” one of multiple modes and directing an encoder, “in response to sensing data received” in one of the modes, to encode data in that mode...Herve fails to anticipate “sending data received at a decoder” in one of multiple modes and encoding data in that mode “in response to sending data received at said decoder...” in page 19, paragraph 3 to page 20, paragraph 1.

**In response to applicant's argument, the examiner respectfully disagrees** that Herve lacks any mention of determining how to encode data using an encoder based on data received by a decoder; Herve fails to anticipate sensing the mode in which incoming information was encoded and then using this mode to both decode the incoming information and to encode outgoing information, Herve fails to anticipated “sensing data received at a decoder in” one of multiple modes and directing an encoder, “in response to sensing data

received" in one of the modes, to encode data in that mode...Herve fails to anticipate "sending data received at a decoder" in one of multiple modes and encoding data in that mode "in response to sending data received at said decoder.

Herve discloses an encoder portion operable to direct said encoder to encode data (see FIG. 1, CODEC 13 and 6 are directed to perform/encode in RNIS, and/or CODEC 24 and 25 are directed to perform/encode in RTC) in one of an industry-compliant mode (see FIG. 1, ISDN mode when the switch 28 is at RNIS) and a custom mode (see FIG. 1, STM mode when the switch 28 is at RTC; see col. 3, lines 40-65); and a decoder portion operable (see FIG. 1, CODEC 13 and 6 are directed to perform/decode in RNIS, and/or CODEC 24 and 25 are directed to perform/decode in RTC), in response to sensing data received in said custom mode at said decoder (see col. 3, lines 63 to col. 4, lines 5; note that the data is received at the decoder in STM mode), to direct: said decoder to decode said received data in said custom mode (see FIG. 1, note that in STM mode switch 28 must be toggled to RTC; upon receiving the data in STM mode, STM decoder RTC 34/38 must be directed/programmed/assigned to decode the data; also note that per FIG. 1 and 2, it is clear that each STM decoder part/portion must decode the data); and said encoder portion to direct said encoder to encode data in said custom mode (see FIG. 1; during STM mode, STM encoder RTC 33/37 must be directed/programmed/assigned to encode the data; also note that per FIG. 1 and 2, it is clear that each STM encoder part/portion must encode the data); see col. 3, lines 40-65.

Note that Herve teaches the encoder (**see FIG. 1, CODEC 13 and 6 are directed to perform/encode in RNIS, and/or CODEC 24 and 25 are directed to perform/encode in RTC**) defines/directs to encode in either RNIS mode or RTC mode by switching to either

RNIS or RTC mode for outgoing information. Similarly, the decoder (see FIG. 1, CODEC 13 and 6 are directed to perform/decode in RNIS, and/or CODEC 24 and 25 are directed to perform/decode in RTC), when (or in response to) sensing/detecting/receiving the data in the RTC mode, it decodes the incoming information in RTC mode. Note that CODECs (i.e. encoder and decoder) must be synchronized in order to encode and decode the data that is the whole purpose and function of CODEC. For example, the data is encoded in RTC mode by the encoder, in response to switching to RTC mode, the decoder must decode in RTC mode in order to decode the data, which is the purpose and function of CODEC. Thus, it is clear that Herve still disclose the applicant argued limitations.

Regarding claims 1 and 18, the applicant argued that, "...Herve fails to anticipate a "decoder portion" in a controller that is operatable to direct a "decoder" to decode received data in a particular mode and to direct an "encoder portion" of the controller to direct an "encoder" to encode data in the particular mode "in response to sensing data received" in the particular mode "at said decoder"..." in page 19, paragraph 3.

In response to applicant's argument, the examiner respectfully disagrees that Herve fails to anticipate a "decoder portion" in a controller that is operatable to direct a "decoder" to decode received data in a particular mode and to direct an "encoder portion" of the controller to direct an "encoder" to encode data in the particular mode "in response to sensing data received" in the particular mode "at said decoder".

Note that claim 18 recites, "a controller...comprising.... an encoder portion...a decoder portion..." in line 5-8. Thus, it is clear that "an encoder portion and a decoder portion" are not limited to be in a controller since the Herve's management system 18 is

clearly controlling, managing and processing the encoder and decoder in the CODECs. Thus Herve teaches a controller comprising an encoder portion...a decoder portion, and an encoder portion of the encoder encodes the data, and the decoder portion of the decoder decodes the data. As shown in Herve FIG. 1, the encoder portion (i.e. encoder of CODEC 13, 6, 24,25), upon receiving the direction/control information from the Management system 18 via Mux/Deumx 14 and 26, directs/manages and performs encoding data in the directed mode (i.e. RTC or RNIS mode). Similarly, the decoder portion (i.e. decoder of CODEC 13, 6, 24,25), upon receiving the direction/control information from the Management system 18 via Mux/Deumx 14/26 and a switch 28, directs/manages and performs decoding data in the directed mode (i.e. RTC or RNIS mode), which is the mode that is used to encoded the data; also see Herve col. 3, lines 5-40.

**Regarding claims 1, 9 and 18, the applicant argued that,** "...Herve lacks any mention of a controller that includes both encoder and decoder portions, where the decoder portion is capable of causing the encoder portion to performs an action...Herve fails to anticipate a controller that includes both an "encoder portion" and "a decoder portion", where the "decoder portion" is capable of causing the "encoder portion" to direct an "encoder" to encode data in a particular mode...page 20, paragraph 2.

**In response to applicant's argument** that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a controller that includes both encoder and decoder portions) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from

the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

**In response to applicant's argument, the examiner respectfully disagrees that Herve lacks any mention of a controller that includes both encoder and decoder portions, where the decoder portion is capable of causing the encoder portion to performs an action...Herve fails to anticipate a controller that includes both an "encoder portion" and "a decoder portion", where the "decoder portion" is capable of causing the "encoder portion" to direct an "encoder" to encode data in a particular mode.**

Note that claim 18 recites, "a controller...comprising.... an encoder portion...a decoder portion..." in line 5-8. Thus, it is clear that "an encoder portion and a decoder portion" are not limited to be in insider the controller since the Herve's management system 18 is clearly controlling, managing and processing the encoder and decoder in the CODECs within a network transceiver. Thus Herve teaches a controller comprising an encoder portion...a decoder portion, and an encoder portion of the encoder encodes the data, and the decoder portion of the decoder decodes the data.

As shown in Herve FIG. 1, CODEC 13,6,24 and 25 perform both encoding and decoding functions under the control of the management system. The decoder portion (i.e. decoder of CODEC 13, 6, 24,25), upon receiving the direction/control information from the Management system 18 via Mux/Deumx 14/26 and a switch 28, directs/manages and performs decoding data in the directed mode (i.e. RTC or RNIS mode). Consequently, once the decoder is set in one specific mode (e.g. RNIS mode), the encoder portion (encoder of CODEC 13, 6, 24,25) must also be set to the same mode (e.g. RNIS mode) so that CODEC is

performing encoding and decoding functions in synchronized manner, which is the whole purpose and function of CODEC. Also, the decoder portion (i.e. decoder of CODEC 13, 6, 24,25), upon receiving the direction/control information from the Management system 18 via Mux/Deumx 14/26 and a switch 28, directs/manages and performs decoding data in the directed mode (i.e. RTC or RNIS mode), and encoder portion (i.e. encoder of CODEC 13, 6, 24,25), upon receiving the direction/control information from the Management system 18 via Mux/Deumx 14/26 and a switch 28, and in accordance with the direction from decoder portion of CODEC, performs encoding data in the directed mode (i.e. RTC or RNIS mode); see Herve col. 3, lines 5-40.

**Regarding claims 8,17,25 and 38, the applicant argued that,** the rejection is traversed due to lack of a prima facie case of obviousness in page 20-22, section III.

**In response to applicant's argument, the examiner respectfully disagrees** that the rejection lack of a prima facie case of obviousness. Herve teaches all argued limitation as set forth above responses and previous office action. Agazzi'916 teaches the wherein said industry-compliant mode is compliant with IEEE 802.3ab (**see FIG. 1, Transceiver block 102 which operates in conformance with IEEE 802.ab. standard; see col. 1, line 34-34, see col. 6, lines 11-20**). Thus, it is clear that the combined system discloses all limitations in the applicant claim.

**In response to applicant's argument** that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves

or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine is to obtain the advantages/benefits taught by Agazzi'916 since Agazzi'916 states at col. 1, line 46 to col. 2, lines 4 that such modification would provide a smooth and non-disruptive evolution from existing standard, and lower cost than other technologies of comparable speed.

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ian N Moore whose telephone number is 571-272-3085. The examiner can normally be reached on M-F: 9:00 AM - 6:00 PM.

Art Unit: 2661

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau T Nguyen can be reached on 571-272-3126. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

INM  
JSM  
3/16/05



BOB PHUNKULH  
PRIMARY EXAMINER